



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/976,851	10/12/2001	Karen H. Bean	11301-0241 (44039-251649)	1701

7590 06/04/2003

John S. Pratt, Esq.
KILPATRICK STOCKTON LLP
Suite 2800
1100 Peachtree Street, N.E.
Atlanta, GA 30309-4530

EXAMINER

NUTTER, NATHAN M

ART UNIT	PAPER NUMBER
----------	--------------

1711

DATE MAILED: 06/04/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/976,851

Applicant(s)

BEAN ET AL.

Examiner

Nathan M. Nutter

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 1-10 and 14-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

Art Unit: 1711

DETAILED ACTION

The restriction requirement of 26 March 2003, Paper No. 5, should have been directed to the groups of claims, as follows:

- I. Claims 1-10, drawn to a polymer blend, classified in class 525, subclasses 191, 221, 222 and 240.
- II. Claims 11-13, drawn to a saturated fibrous web, classified in class 428, subclasses 500, 507, 509, 511, 512, 513, 514 and 515.
- III. Claims 14-16, drawn to a "package or container", classified in class 428, subclasses 34.1, 34.2, 34.3, 35.7, 36.1 and 36.92.
- IV. Claims 17-19, drawn to a method for coating a fibrous web, classified in class 427, subclasses 372.2, 407.1, 412.1, 412.2, 412.3, 430.1 and 439.
- V. Claim 20, drawn to "a method for making a package", classified in class 493, subclasses 51, 52, 328 and 329.

Election/Restrictions

Applicant's election with traverse of Group II, claims 11-13, in Paper No. 6 of 5 May 2003 is acknowledged. The traversal is on the ground(s) that since "each group of claims features a composition having a drapable saturant composition and an additional saturant polymer", i.e. "Group I claims this composition; Group II... provides a fibrous web including this composition; Group III provides a package having this fibrous web including this composition; Group IV provides a method of making this composition; and Group V provides a method of making a package using the fibrous web including this composition", a "search for any of Groups II-V would necessitate a search of the

Art Unit: 1711

composition" and the "search and examination of the entire application could be made without serious burden". This is not found persuasive because the vast number of classes and subclasses thereof, as pointed out above, would clearly be indicative of a burdensome search. This, and the bases of the restriction as originally set out, preclude the rejoinder of Groups I-V.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 11-13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The instant claims are drawn to fibrous web structures that are saturated with copolymer compositions defined by reference to desired characteristics and properties, such as "providing an enhanced seal strength between a fibrous web and a base component polymeric material when used as a saturant for a fibrous web". The claims cover all compositions having this characteristic or property, whereas the Specification provides support for only a limited number of such compositions. In the present case,

Art Unit: 1711

the claims so lack support, and the application so lacks disclosure, that a meaningful search over the whole of the claimed scope is impossible. To determine what may be included thereby would require the undue burden of experimentation.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 11-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. This claim is an omnibus type claim.

The claims are deemed to lack clarity, since an attempt is made to define the composition by reference to a result to be achieved. As such, this lack of clarity in the present case is such as to render a meaningful search over the whole of the claimed scope is such as to render a meaningful search over the whole of the claimed scope impossible. As such, the instant claims are deemed to be vague and confusing.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 1711

Claims 11-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Graham et al ('502) or ('424), Bergomi, Jr., Bergomi, Jr. et al, Isaac et al ('518) or ('910), Wierer et al, Weber et al ('828) or Kapik et al (WO 99/00549, all cited by applicants, or DeLapp, Huffman et al, Goebel et al, Sheldon et al, Weber et al ('070), Stokes or Robertson et al, all newly cited.

The instant claims recite a fibrous web structure that may comprise the web, a "saturant composition" and "an additional saturant polymer". The "additional saturant polymer" may be "selected from homopolymers and heteropolymers (*sic*) of lower alkenes". Any characteristics of the compositions employed in such capacities would be inherent in those compositions.

Graham et al ('502) shows such combination at column 1 (lines 18-27) and the Examples. Graham et al ('424) teaches the product at the Abstract, the many Examples and column 8 (lines 43-51)

Bergomi, Jr. teaches the product at the Abstract, Examples 3 and 4 at columns 7 and 8.

Bergomi, Jr. et al teach the product at the Abstract, the many Examples and column 9 (line 1) to column 10 (line 12).

The reference to Isaac et al ('518) teaches the product at the paragraph bridging column 2 to column 3. Isaac et al ('910) teach the product at column 3 (lines 7-20), column 4 (lines 16-36) and the Examples.

The patent to Wierer et al teaches the web structure at the Abstract, column 1 (line 36) to column 2 (line 41) and the Examples.

Art Unit: 1711

The reference to Weber et al ('828) teaches the contemplated structure at column 2 (lines 14-62) and the Examples.

In the Kapik et al document note the Abstract, page 8, 1st full paragraph, page 9 (line 20) to page 10 (line 30).

The reference to DeLapp teaches the contemplated structure at the Abstract and the many Examples.

The Huffman et al patent teaches the structure at the Abstract and the many Examples.

Goebel et al teach the web structure at the Abstract and the many Examples.

In Sheldon et al, note column 2 (lines 17-46) and the claims.

Weber et al ('070) shows the contemplated web structure at column 2 (lines 35-46), column 3 (lines 35-53), the many Examples and claims 15-21.

The reference to Stokes shows the contemplated structure at the Abstract, column 1 (line 38) to column 2 (line 37), column 3 (lines 3-52) and the Examples.

Finally, the patent to Robertson et al teaches the claimed structure at the Abstract, the Examples and the claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan M. Nutter whose telephone number is 703-308-2443. The examiner can normally be reached on Monday-Friday 9:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 703-308-2462. The fax phone numbers

Art Unit: 1711

for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

A handwritten signature in black ink, appearing to read "Nathan M. Nutter". The signature is fluid and cursive, with the first name "Nathan" being larger and more prominent than the last name "Nutter".

Nathan M. Nutter
Primary Examiner
Art Unit 1711

nmn
June 2, 2003